

Response

The claims were amended in accordance with the amendments above. The amendments to the claims are being made to clarify the invention and to focus the claims on those aspects of the invention which are a commercial priority to the assignee. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

In the Office Action dated 12/15/2005, claims 24-25, 28, 31-33, 37, 39-40, 43-45, and 47-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamaguchi et al. (U.S. 6,400,392). Claims 26-27, 30, 34-36, and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamaguchi et al. in view of Atick et al. (U.S. 6,111,517). Claims 23 and 41 were rejected under were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamaguchi et al. in view of Atick et al. in further view of Sankaranarayan et al. (U.S. 6,799,208). Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Applicants note that the art of record fails to teach or suggest all of the limitations recited in each independent claim, particularly in the arrangement required by each of the independent claims. Thus, a case of obviousness in accordance with MPEP 2143.03 cannot be established. For instance, and without limitation, present independent 43 recites an act of determining whether to degrade the image comprising determining whether the user is active or inactive, wherein the step of determining whether the user is active or inactive comprises determining whether a window displaying the image is fully visible to the user, wherein the act of determining whether a window displaying the image is fully visible to the user comprises determining whether at least a portion of the image is visually obstructed. Applicant respectfully submits that the combined art of record fails to teach or suggest these limitations. Accordingly,

the combined art of record fails to render present claim 43 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

Similarly, Applicant notes that present independent claim 49 recites an act of determining whether to degrade the image comprising determining whether the user is active or inactive, wherein the step of determining whether the user is active or inactive comprises determining whether a window displaying the image is fully visible to the user, wherein the act of determining whether a window displaying the image is fully visible to the user comprises determining whether at least a portion of the image is visually obstructed. Applicant respectfully submits that the combined art of record fails to teach or suggest these limitations. Accordingly, the combined art of record fails to render present claim 49 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

Independent claim 50 recites an act of determining whether to degrade the image comprising determining whether the user is active or inactive, wherein the act of determining whether the user is active or inactive comprises determining whether the image is fully visible to the user, wherein the act of determining whether the image is fully visible to the user comprises determining whether at least a portion of the image is visually obstructed. Applicant respectfully submits that the combined art of record fails to teach or suggest these limitations. Accordingly, the combined art of record fails to render present claim 50 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the present claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Ultimately, the Office Action fails to provide the requisite *evidence* in the prior art suggesting the desirability of the combinations claimed herein, but instead relies solely on

conclusory statements and impermissible hindsight reconstruction. Because the motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Beyond the foregoing shortcomings with respect to the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully Submitted,



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